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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,925

11/04/2003

John McGrath

1581-3/JLW

3884

38735

7590

05/12/2006

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EXAMINER

LAUX, JESSICA L

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,925	<b>Applicant(s)</b> MCGRATH, JOHN	
	<b>Examiner</b> Jessica Laux	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/04/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Double Patenting***

Claims 1-14 of this application conflict with claims 1-14, 19-21 & 25-35, and 48-53 of Application No. 11/101525. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14, 19-21 & 25-35, and 48-53 of copending Application No. 11/101525. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Election/Restrictions***

Group I, claims 1-14 have been elected in the Response to Restriction Requirement dated April 13, 2006. Accordingly claims 15-18 have been cancelled.

***Specification***

The abstract of the disclosure is objected to because Page 2, paragraph 0007, line 5 recites "beneficial top provide". Examiner suggests changing to recite: beneficial to provide". Correction is required.

The abstract of the disclosure is objected to because is of undo length. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rygiel (6237294).

In regards to claim 1: Rygiel teaches a construction panel for applying a simulated rock facade to a structure, comprising: a settable material having an exterior face formed to a desired appearance (Col. 2, lines 56-58; and Abstract), and a mesh (Abstract; Col. 5, lines 2-3 and 16-21) permeable to the settable material, embedded in the settable material, whereby the mesh integrates a plurality of simulated rock faces, and a plurality of panels can be installed in contiguous abutting relation to simulate a rock wall (Col. 4, lines 12-16).

In regards to claim 2: The construction panel of claim 1 above, in which the mesh is flexible (Col. 7, lines 20-29).

In regards to claim 3: The construction panel of claim 1 above, in which the rock faces and mesh are anchored to a backing board (Col. 8, line 57).

In regards to claim 4: The construction panel of claim 3 above, in which backing board comprises a foam insulation board (Col. 8, lines 57-60).

In regards to claim 6: The construction panel of claim 1 above, in which the settable material forms grout lines (Figure 1, element 12) between simulated rock faces (Figure 1, element 11).

In regards to claim 14: Rygiel discloses the construction panel of claim 1 above, and further discloses a kit for making a plurality of such panels to be installed on a wall (Col. 3, lines 7-9), wherein one or more accessory panels having at least one flat edge (Col. 6, lines 57, where the mold is square with flat edges) that are capable of being used for finishing an edge of the rock facade.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rygiel (6237294) in view of Painter (3504469).

In regards to claim 7: Rygiel discloses the construction panel of claim 1 above, and further discloses that each panel may have an interlocking pattern so that it may be placed along side another panel in interlocking fashion (Col. 6, lines 54-57). Rygiel is silent as to design of the interlocking edge. Painter discloses a construction panel having complementary top and bottom edges (Figure 1), each of said edges comprising a repeating profile (Figure 1 and Col. 2, lines 63-64 where Painter discloses the edge to be sinusoidal which is a repeating profile) whereby a plurality of panels can be installed in contiguous abutting relation with either an entire top edge of one panel abutting an entire bottom edge of an adjacent panel or a portion of a top edge of one panel abutting a portion of a bottom edge of another panel. The limitation "can be installed" is a method step in an apparatus claim and as such is considered to be a capability statement. The panel of Painter is capable of being installed in the claimed manner. One of ordinary skill in the art at the time the invention was made would have been motivated to use the interlocking relationship of Painter with the panel of Rygiel as such an interlocking would render the panel seams invisible.

In regards to claim 8: The construction panel as taught by Rygiel in view of Painter in claim 7 above, wherein the repeating profile is a periodic curve that is preserved by the transformation comprising an inversion operation and a phase shift equal to half the length of the repeating profile (Col. 2, lines 63-64 where a sinusoidal curve is preserved by the transformation comprising an inversion operation and a phase shift equal to half the length of the repeating profile as disclosed by applicant in paragraph 0035 and Figure 8).

In regards to claim 9: The construction panel as taught by Rygiel in view of Painter in claim 8 above, wherein each panel has complementary side edges, each of said side edges comprising the repeating profile (Painter – Figure 1) whereby a plurality of panels can be installed in contiguous abutting relation with a portion of a top, bottom or side edge of one panel abutting a portion of a top, bottom, or side edge of another panel (The limitation “can be installed” is a method step in an apparatus claim and as such is considered to be a capability statement. The panel of Rygiel in view of Painter is capable of being installed in the claimed manner).

In regards to claim 12: The construction panel as taught by Rygiel in view of Painter as in claim 7 above, in which each panel has side edges each having a profile corresponding to at least a portion of the repeating profile of one of the top or bottom edges (Painter - Figure 1) whereby a plurality of panels is capable of being installed in contiguous abutting relation with a side edge of one panel abutting a portion of top or bottom edge of another panel.

In regards to claim 13: The construction panel of claim 12 in which the settable material forms a half grout line around a periphery of the panel (Rygiel - Col. 4, lines 33-41; where the grout line would be half a grout line when placed next to a similar panel having the same periphery).

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rygiel in view of Painter as applied to claims 7-9 above, and further in view of Mason (3524790). Rygiel in view of Painter discloses the panel as in claims 7-9 above, but does not teach the panel comprising a cutting profile. Mason teaches masonry stone

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panel having a cutting profile. It would have been obvious to one of ordinary skill in the art would have been motivated to modify the panel as disclosed by Rygiel in view of Painter to have the cutting profile as taught by Mason, since such a profile to further disguise panel edges making a more realistic looking stone façade.

In regards to claim 10: The construction panel as taught by Rygiel in view of Painter as in claim 7 above does not teach a cutting profile. Mason discloses a panel having simulated masonry stones, wherein the panel comprises a cutting profile complementary to the top or bottom edge of the panel and comprising the repeating profile (Col. 1, lines 54-61), such that the panel is capable of being cut along the cutting profile to produce a panel with a new top or bottom edge that can be installed in contiguous abutting relation with an adjacent panel, with at least a portion of either the new top or bottom edge of said panel abutting at least a portion of a bottom or top edge of the adjacent panel.

In regards to claim 11: The construction panel as taught by Rygiel in view of claim Painter as in claim 9 above, wherein the panel comprises a cutting profile complementary to the top, bottom, or side edge of the panel and comprising the repeating profile (Col. 1, line 54 - Col. 2, lines 2) such that the panel is capable being cut along the cutting profile to produce a panel with a new top, bottom, or side edge that can be installed in contiguous abutting relation with an adjacent panel, with at least a portion of the new top, bottom, or side edge of said panel abutting at least a portion of a top, bottom, or side edge of the adjacent panel.



Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rygiel (6237294) in view of Mayrand (5230191).

In regards to claim 5: Rygiel teaches the construction panel of claims 1 and 3 above, but does not teach the backing board having holes. Mayrand teaches a construction panel of concrete adhered to insulating foam in which the foam backing comprises holes (Col. 4, lines 42-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the panel of Rygiel with the simulating rock faces on the front and the foam insulating backing board to have holes in the foam as taught by Mayrand since such a modification would provide a secure bond and connection between the foam and cement.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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05/02/2006



N. Slack  
Primary